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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,350	11/17/2000	David Montgomery	0500.0003231	6328

23418 7590 12/19/2006  
VEDDER PRICE KAUFMAN & KAMMHOLZ  
222 N. LASALLE STREET  
CHICAGO, IL 60601

EXAMINER.
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SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/715,350		MONTGOMERY, DAVID	
	<b>Examiner</b>		<b>Art Unit</b>	
	Michael J. Simitoski		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,12-17,19-21,24-33,35 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-7,12-15,30-33,35-37,39,45 and 46 is/are allowed.
- 6) ☒ Claim(s) 16,17,19-21,24-29,38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The response of 9/26/2006 was received and considered.
2. Claims 1-2, 4-7, 12-17, 19-21, 24-33, 35, 37-46 are pending.

### ***Response to Arguments***

3. Applicant's arguments filed 9/26/2006 have been fully considered but they are not persuasive.
4. Applicant's response (p. 2) amends the specification, replacing "executing software applications" with "software applications". It is first noted that the single-bracket "[" is not appropriate for illustrating the deletion of subject matter. Newly deleted matter should be denoted with a strikethrough or within double brackets if a strikethrough would not be easily perceived, as per 37 CFR §1.121(b)(1)(ii). This also applies to the amendments made to claim 41.
5. Applicant's response (p. 16, ¶1) argues that Applicant has amended all of the independent claims to include subject matter from allowable claim 3. It is noted that all independent claims are allowable if the rejections under 35 U.S.C. §101 set forth below are overcome.
6. Applicant's response (p. 16, ¶2) argues that one having ordinary skill in the art would not read the claims as directed to non-statutory subject matter because the specification discloses executing software applications. However, the specification's disclosure of "software applications" is not limited to (with respect to the previous §101 rejections) the software applications being tangibly embodied on a computer readable medium where a functional interrelationship exists between the software application and the medium. An example of a

functional interrelationship is “wherein the medium is coupled to a computer such that the instructions are read and executed by said computer”. Therefore, the rejections set forth in the previous Office Action under §101 are maintained.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 16-17, 19-21, 24-29, 38 & 40-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to subject matter not necessarily carried out using a computer or an apparatus containing software, per se (see pp. 10-11 of the instant specification).

- a. Regarding claim 16, the claim recites an apparatus, but the specification discloses the certificate set generator as being a software application. Therefore, an apparatus comprising only software is software because the software is not tangibly embodied and there is no functional interrelationship between a medium on which the software application is stored and the software application. This could be remedied by reciting that the apparatus comprises a processor and storage medium, that the signed certificate generator is stored on a storage medium and the operations of the signed certificate generator executed by a processing unit, as recited on p. 19, ¶2 of the specification.
- b. Regarding claim 26, the line of reasoning is substantially similar to the reasoning above regarding claim 16.

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c. Regarding claim 38, the claim presents a method, but it does not produce a useful, concrete and tangible result. While a signed certificate set is created, the set is not used for anything or transmitted. This could be remedied by including a useful, concrete and tangible result such that (for example) the signed certificate is transmitted to a recipient.

d. Regarding claims 40-44, the rationale is similar to that of claim 38.

***Allowable Subject Matter***

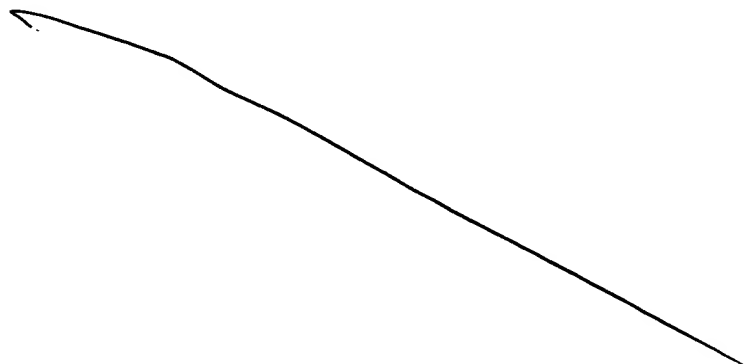
9. Claims 1-2, 4-7, 12-15, 30-33, 35-37, 39 & 45-46 are allowed.

10. Claims 16-17, 19-21, 24-29, 38 & 40-44 would be allowable if the above rejections under 35 U.S.C. §101 are overcome.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



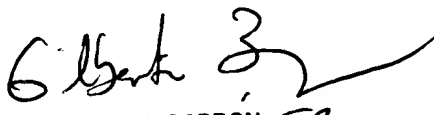
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS



December 12, 2006



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